

Remarks

Claims 1 to 24 are pending. Applicants amended claims 17 and 22 to correct a grammatical and a spelling error, respectively. Applicants amended claims 1, 10, 12, 14, 16, 17, 18, and 24 to replace "film" with "layer" to more clearly present the claimed subject matter. Applicants amended claim 2 to clarify that the two layers are laminated together to form a laminate and that the laminate is durable. Applicants amended claims 2 and 23 to replace "with the proviso that" with "wherein." Applicants amended claim 24 to clarify that the printed surface of the first layer is laminated to another layer. No new matter has been added. The amendments to claims 1, 2, 10, 12, 14, 16, 17, 18, 23 and 24 were not in response to any documents cited in the office action.

§ 102 Rejections

Claims 1, 2, 23 and 24 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Pat. No. 5,380,046 to Stephens (hereinafter "Stephens"). The Examiner asserted that "Stephens discloses all of the subject matter as set forth in the claims and is identical to the invention as broadly recited. Some of the claimed elements clearly disclosed by the reference are: a security feature (16), a transparent fragile layer (12') and a transparent durable layer (12'')." Applicants respectfully traverse the rejection as follows.

Claim 1

Applicants respectfully submit that Stephens fails to teach all of the elements recited in claim 1. For example, Stephens fails to teach both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1. The Examiner asserts that the "transparent fragile layer" and the "transparent durable layer" recited in claim 1 are taught by Stephens' "rectangular plies 12' and 12'\"", respectively. Stephens, however, fails to support this assertion. Stephens provides that "the plastic envelope 12 comprises dual rectangular plies 12', 12" of a transparent thermoplastic material secured to one another along one corresponding edge" (Col. 3, lines 7-9). So, Stephens provides only a single type of material for the "rectangular plies 12' and 12'\"" of the plastic envelope 12. Applicants respectfully submit that the single type of material provided by

Stephens is not taught to have dissimilar properties. Thus, Stephens fails to teach both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1.

Stephens also fails to teach "at least one security element," as recited in claim 1. The Examiner asserts that the "security feature" is disclosed in Stephens' "information card 16." Stephens, however, fails to support this assertion. Stephens provides that the "information card 16" is not a "security element" as recited in claim 1, but rather "comprises a rectangular paper blank 18" on which to provide personal information (Col. 2, lines 54-55). In contrast, Applicants teach that at least one security feature can include "the destruction of the fragile layer indicating tampering or attempted delamination . . . holograms and other diffractive optically variable images, embossed images, and color-shifting films . . . images only visible under certain conditions such as inspection under light of a certain wavelength, polarized light, or retroreflected light" (page 3, lines 26-32). Stephens fails to teach any of these security features. Thus, Applicants respectfully submit that Stephens does not teach the "at least one security element" recited in claim 1.

As such, each and every element of independent claim 1 is not taught in Stephens. Therefore, the § 102 rejection should be withdrawn.

Claim 2

Applicants respectfully submit that Stephens fails to teach all of the elements recited in claim 2. For example, as discussed above for claim 1, Stephens fails to teach the "at least one security element," as recited in claim 2.

In addition, Stephens fails to teach "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. The Examiner has indicated that with respect to the "plastic envelope 12" that "[s]ome of the claimed elements clearly disclosed by the [Stephens] reference are: . . . a transparent fragile layer (12') and a transparent durable layer (12')." Applicants respectfully note that while the Examiner has asserted Stephens provide "a transparent fragile layer (12')," the Examiner has failed to clearly identify where Stephens provides "a second transparent fragile layer," as recited in claim 2.

Applicants further submit that Stephens fails to teach a "transparent fragile layer," as recited in claim 2. Stephens provides that the "plastic envelope 12 [that] comprises dual

rectangular plies 12', 12" of a transparent thermoplastic material" is rugged enough to be "laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack or bookbag [sic], etc." (Col. 3, lines 7-27). Stephens even provides that the information packet includes a "cutting line or lines along which to open the packet, e.g., by the use of scissors as shown in FIG. 4, to obtain access to the information." (Col. 3, lines 35-41). In contrast, Applicants use the term "fragile" in the "transparent fragile layer" to mean "a film or material that is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing" (page 2, lines 24-26). Thus, Applicants respectfully submit that the plastic envelope provided by Stephens does not teach the "transparent fragile layer" recited in claim 2.

As such, each and every element of independent claim 2 is not taught in Stephens. Therefore, the § 102 rejection should be withdrawn.

Claims 23 and 24

The Examiner asserted that "Stephens inherently teaches the method in claims 23 and 24." The inherent disclosure of a document may be relied upon in the rejection of claims under 35 U.S.C. §102. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App & Inter. 1990) (emphasis in original). Applicants respectfully submit, however, that the Examiner has provided no objective evidence or cogent technical reasoning to support the conclusion of inherency. As such, a proper rejection based on inherency has not been made.

In addition, Applicants respectfully submit that Stephens fails to teach all of the elements recited in claims 23 and 24. For example, as discussed above for claim 2 Stephens fails to teach a fragile layer. In addition, Stephens fails to teach printing on a fragile layer, or that a printable surface can be provided on a fragile layer. Thus, Stephens fails to teach providing a printable surface of a first fragile layer, as recited in claim 23.

Stephens further fails to teach providing a second layer, which is a durable layer or is a fragile layer, wherein the combination of the first and second layer provide a durable sheet, as recited in claim 23. For example, as discussed above for claim 1 Stephens fails to teach both a

"transparent fragile layer" and a "transparent durable layer," as recited in claim 23. In contrast, Stephens provides only a single type of material for the "rectangular plies 12' and 12"" of the plastic envelope 12.

Stephens also fails to teach both a "first fragile layer" and a "second layer, which . . . is a fragile layer," as recited in claim 23. For example, as discussed above for claim 2 the Examiner has failed to clearly identify where Stephens teaches a second fragile layer, as provided in claim 23. In fact, as discussed above for claim 2 Stephens fails to teach a "fragile layer." As such, Stephens fails to teach providing a printable surface of a first fragile layer, and providing a second layer, which is a durable layer or is a fragile layer, as provided in claim 23.

With respect to claim 24, Stephens fails to teach, besides other things, printing identification information onto a surface of a first layer, where the layer is optically transparent, as recited in claim 24. In contrast, Stephens provides that personal information can be provided on an "information card 16 [that] basically comprises a rectangular paper blank 18" (Col. 2, lines 54-55). Stephens fails to teach that the "rectangular paper blank 18" is optically transparent. So, Stephens fails to teach printing identification information onto a surface of a first layer, where the layer is optically transparent, as recited in claim 24.

Finally, Stephens fails to teach that one of the first layer and another layer is more fragile than the other, as recited in claim 24. For example, as discussed above for claim 1 Stephens provides only a single type of material for the plastic envelope 12 that was not identified as having dissimilar properties. Thus, Stephens fails to teach that the plastic envelope 12 includes a first layer and another layer that is more fragile than the other, as recited in claim 24.

As such, each and every element of independent claims 23 and 24 are not taught in Stephens. Therefore, the § 102 rejection should be withdrawn.

Reconsideration and withdrawal of the § 102 rejection for the above independent claims, as well as those claims which depend therefrom, are respectfully requested.

§ 103 Rejections**Claims 9, 12 and 13**

Claims 9, 12 and 13 stand rejected under 35 USC § 103(a) as being unpatentable over Stephens. Applicants respectfully traverse the rejection as follows.

As discussed above, Stephens fails to teach or suggest both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1. Stephens also fails to teach or suggest "at least one security element," as recited in claims 1 and 2. In addition, Stephens fails to teach or suggest "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens. As claims 9 and 13 are dependent claims of independent claims 1 and 2, and claim 12 is a dependent claim of independent claim 1, the §103 rejection of claims 9, 12 and 13 should be withdrawn.

The rejection of claims 9, 12 and 13 under 35 USC § 103(a) as being unpatentable over Stephens has been overcome and should be withdrawn. Reconsideration and withdrawal of the § 103 rejection for claims 9, 12 and 13 are respectfully requested.

Claims 3 and 5

Claims 3 and 5 stands rejected under 35 USC §103(a) as being unpatentable over Stephens in view of U.S. Pat. No. 5,342,672 to Killey. Applicants respectfully traverse the rejection as follows.

As discussed above, Stephens fails to teach or suggest both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1. Stephens also fails to teach or suggest "at least one security element," as recited in claims 1 and 2. In addition, Stephens fails to teach or suggest "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens.

The Examiner cited Killey to illustrate a holographic thermal transfer ribbon. Killey, however, does not cure the above identified deficiencies of Stephens. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens and Killey, either

independently or in combination. As claims 3 and 5 are dependent claims of independent claims 1 and 2, the § 103 rejection of claims 3 and 5 should be withdrawn.

The rejection of claims 3 and 5 under 35 USC § 103(a) as being unpatentable over Stephens in view of Killey has been overcome and should be withdrawn. Reconsideration and withdrawal of the § 103 rejection for claims 3 and 5 are respectfully requested.

Claims 4, 6-8, 10, 11, 14-21

Claims 4, 6-8, 10, 11, 14-16 and 19-21 stand rejected under 35 USC §103(a) as being unpatentable over Stephens in view of U.S. Pat. No. 4,968,063 to McConville et al. Claims 17 and 18 stand rejected under 35 USC §103(a) as being unpatentable over Stephens in view of McConville and Killey. Applicants respectfully traverse the rejection as follows.

As discussed above, Stephens fails to teach or suggest both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1. In addition, Stephens fails to teach or suggest "at least one security element," as recited in claims 1 and 2. Stephens also fails to teach or suggest "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens.

As claims 4, 6-8 and 19 are dependent claims of independent claims 1 and 2; claims 10, 11, 14, 16 and 18 are dependent claims of independent claim 1; claims 15 and 17 are dependent claims of independent claim 2; and claims 20 and 21 recite claims 1 and 2 as an element, the §103 rejection of claims 4, 6-8, 10, 11, 14-21 should be withdrawn.

The rejection of claims 4, 6-8, 10, 11, 14-16 and 19-21 under 35 USC § 103(a) as being unpatentable over Stephens in view of McConville et al. has been overcome and should be withdrawn. In addition, the rejection of claims 17 and 18 under 35 USC § 103(a) as being unpatentable over Stephens in view of McConville and Killey has been overcome and should be withdrawn.

Reconsideration and withdrawal of the § 103 rejection for claims 4, 6-8, 10, 11, 14-21 are respectfully requested.

In view of the above, it is submitted that the application is in condition for allowance.
Reconsideration of the application is requested.

Respectfully submitted,

April 5, 2004

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